

## REMARKS

Reconsideration and further examination of the subject patent application in light of the present Amendment and Remarks is respectfully requested. Claims 48-77 are currently pending in the application. Claims 48-77 stand rejected.

### Rejections under 35 U.S.C. §103

Claims 48-77 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Pat. No. 3,259,428 to Swartz in view of U.S. Pat. No. 5,386,351 to Tabor. Applicant respectfully traverses this rejection.

It is noted first that independent claims 48, 60 and 72 are limited to “a housing including at least one side cover disposed on a first side of the housing adjacent the power source that encloses the power source, the at least one side cover having a plurality of colors disposed on an outer surface thereof”. In this regard, the Examiner asserts that “It would have been obvious . . . to add markings or indicia to the sides or surface, since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).” (Office Action of 3/30/05, page 3).

However, the law has changed since the 1947 In re Seid decision and the Examiner is clearly in error because markings and indicia can, in fact, be relied upon to patentably distinguish a claimed invention from the prior art. For example, in 1999, the image of a jack-o’-lantern face on a trash bag filled with material was held to be a non-obvious feature over trash bags and jack-

o'-lanterns in general (In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999)). The Examiner is respectfully referred to MPEP §2144.04 for a discussion of aesthetic features that have no mechanical function but still provide a basis for the granting of a utility patent.

The case of In re Dembiczak is directly analogous the markings or colors on the side covers of the claimed flashlight. As a rationale for its finding, the court in In re Dembiczak stated that "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references" (In re Dembiczak, 50 USPQ2d 1617).

With regard to the claimed invention, the Examiner has failed to provide any reference that recognizes any need or motivation for placing markings or a plurality of colors on the side covers of a flashlight. For example, under the claimed invention, "The use of engraving or printing on the side covers can be used for promotional or advertising purposes" (specification, paragraph bridging pages 23-24). In addition, "a flashlight bearing certain markings on the side covers could serve as a prize or be used to commemorate an important event" (specification, page 24, lines 1-2). Since the prior art fails to recognize the problem solved and, conversely, the opportunity provided by the claimed invention, there would be no reason for a practitioner to modify the prior art in the manner suggested by the Examiner.

In addition, the use of engraving or printing does not simply involve the use of conventional side covers. In the case of engraving, the process of engraving structurally changes the side cover to produce the desired image(s). Similarly, printing involves the deposition of colored coatings that may be in addition to the structure of the side covers.

Further, the colors may be provided in ways that are functionally superior to the covers of Schwartz and Tabor. For example, in the case of translucent side covers, “indicia may be engraved or printed on the inside surface of the side cover . . . Thus, the side cover protects the indicia from being marred by normal wear and tear, and also by virtue of being translucent, may provide an attractive gloss finish highlighting the indicia” (specification, page 10, lines 2-5).

In addition to the use of colors, the claimed flashlights may be used in licensing arrangements to commercial advantage. For example, “a flashlight having a green side cover on one side and a yellow side cover on the other side could be used to represent the colors of the Green Bay Packers . . . In addition, a Green Bay Packers logo could be included on one or both side covers of the flashlight” (specification, page 11, lines 2-5).

For any of the above reasons, the use of a plurality of colors is not taught or suggested by the combination of Swartz and Tabor or by the combination of Swartz and Tabor. Since combination does not teach or suggest each and every claim element, the rejection is believed to be improper and should be withdrawn.

#### Closing Remarks

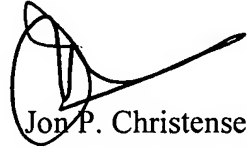
For the foregoing reasons, applicant submits that the subject application is in condition for allowance and earnestly solicits an early Notice of Allowance. Should the Primary Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, the Primary Examiner is respectfully requested to call the undersigned at the below-listed number.

The Commissioner is hereby authorized to charge any additional fee which may be

required for this application under 37 C.F.R. §§ 1.16-1.18, including but not limited to the issue fee, or credit any overpayment, to Deposit Account No. 23-0920. Should no proper amount be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 23-0920. A duplicate copy of this sheet(s) is enclosed.

Respectfully submitted,  
WELSH & KATZ, LTD.

By

A handwritten signature in black ink, appearing to read "Jon P. Christensen", written over a circular stamp.

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September 26, 2005  
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